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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/623,865	11/08/2000	Otto Plank	PA 29584	9306

7590

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EXAMINER

COZART, JERMIE E

ART UNIT

PAPER NUMBER

3726

DATE MAILED: 08/05/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/623,865

Applicant(s)

PLANK, OTTO

Examiner

Jermie Cozart

Art Unit

3726

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 31 May 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-3, 5 and 6 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-3, 5 and 6 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 08 November 2000 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Claim Objections***

1. Claims 1-3, 5, and 6 are objected to because of the following informalities: In claim 1, line 11, it is suggested to delete "other," preceding "rear", in line 15, it is suggested to insert --,-- after "(2)". In claim 2, line 5, it is suggested to change "work [ ] piece" to --work piece--. Appropriate correction is required.

### ***Claim Rejections - 35 USC § 112***

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 1-3, 5, and 6 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

4. Claim 1 recites the limitation "the cross-sectional surface of the opening of the rim hole" in lines 8-9 of the claim. There is insufficient antecedent basis for this limitation in the claim.

5. Claim 1 recites the limitation "the direction feed" in line 12 of the claim. There is insufficient antecedent basis for this limitation in the claim.

6. Claim 2 recites the limitation "the surface facing matrix (8)" in line 4 of the claim. There is insufficient antecedent basis for this limitation in the claim.

### ***Claim Rejections - 35 USC § 102***

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

8. Claims 1, 5, and 6 are rejected under 35 U.S.C. 102(b) as being anticipated by Bartelheim.

Regarding claim 1, Bartelheim discloses producing a rim hole (26) through a stack of at least two plate-shaped work pieces (20,21) using a rim hole punch (10), driven vertically through the stack, wherein material (23) of one of the plate-shaped work pieces (21), which faces the rim hole punch, is pushed through an opening of another rear plate-shaped work piece (20), where inside contours of the opening correspond to outer contours of the rim hole. Bartelheim creates a penetration opening ([not labeled] formed by the punch as it pierces the work pieces in Figure 2) through the stack (20,21), the penetration opening has a cross-section surface corresponding at most to the cross-sectional surface of the opening of the rim hole (26), and forms in a single feed movement of the rim hole punch (10), both the rim hole and the opening (not labeled, see Figures 2 and 3) in the rear plate-shaped work piece (20) seen from the direction of feed, by having the rear plate-shaped work piece (20) pointing away from the rim hole punch (10) supported by a matrix (11), and breaks out when the rim hole punch is driven the stack (20,21), a piece of material (28) of the rear plate-shaped work piece (20) the outer contours of which piece of material (28) correspond to the outer contours of the rim hole (26). See Figures 1-3, and columns 1 and 2 for further clarification.

Regarding claim 5, Bartelheim discloses the penetration opening (not labeled, see Figure 2) being created through the stack with an essentially constant cross-section.

Regarding claim 6, Bartelheim discloses the penetration opening (not labeled, see Figure 2) being created with the feed movement of the rim hole punch (10) by means of the rim hole punch (10) and by which the rim hole (26) and the piece of material (28) are formed.

***Claim Rejections - 35 USC § 103***

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

10. Claims 1-3, 5, and 6 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ashby et al. in view of Bartelheim.

Regarding claim 1, Ashby discloses producing a rim hole (not labeled, see Figure 1A) through a stack of at least two plate-shaped work pieces (82,84) using a hole punch (54), driven vertically through the stack, wherein material (88) of one of the plate-shaped work pieces (82), which faces the hole punch, is pushed through an opening (not labeled) of another rear plate-shaped work piece (84), where inside contours of the opening correspond to outer contours of a rim hole (not labeled, see Figure 1A). Ashby creates a penetration opening (not labeled, see Figure 5) through the stack (82,84), the penetration opening has a cross-section surface corresponding at most to the cross-

sectional surface of the opening of the rim hole, and forms in a single feed movement of the hole punch (10), both the rim hole (not labeled, see Figure 1A) and the opening (not labeled, see Figure 5) in the other rear plate-shaped work piece (84) seen from the direction of feed, by having the rear plate-shaped work piece (84) pointing away from hole punch supported by a matrix (74).

Regarding claim 2, Ashby discloses wherein at the end of the feed movement of the hole punch (54), the rim hole provides over the surface of rear plate-shaped work piece facing matrix (74). See Figures 1A and 8 for further clarification.

Regarding claim 3, Ashby discloses flanging the rim hole by means of a flange punch (64) fed from a side of the work pieces opposite the hole punch (54), whereby after flanging an outer surface of the rim rests at least in some sections on an outer surface of the rim hole. See Figure 8 for further clarification.

Regarding claim 5, Ashby discloses the penetration opening (not labeled, see Figure 5) being created through the stack with an essentially constant cross-section.

Regarding claim 6, Ashby discloses the penetration opening (not labeled, see Figure 5) being created with the feed movement of the hole punch (54) by means of the rim hole punch (54) and by which the rim hole (not labeled, see Figure 1A) is formed.

Ashby, however, does not disclose a rim hole punch, which breaks out when the rim hole punch is driven the stack, a piece of material of the rear plate-shaped work piece the outer contours of which piece of material correspond to the outer contours of the rim hole, or the piece of material being formed by the feed movement of the rim hole punch.

Bartelheim discloses a rim hole punch (10), which breaks out when the rim hole punch is driven the stack of work pieces (20, 21), a piece of material (28) of the rear plate-shaped work piece (20), the outer contours of which piece of material (28) correspond to the outer contours of a rim hole (26), and the piece of material (28) being formed by the feed movement of the rim hole punch (10). See Figures 2-3, and columns 1 and 2 for further clarification.

Therefore, it would have been obvious to one of ordinary skill in the art at the time of invention to provide a rim hole punch in place of the hole punch of Ashby which breaks out when the rim hole punch is driven the stack, a piece of material of the rear plate-shaped work piece the outer contours of which piece of material correspond to the outer contours of the rim hole, and wherein the piece of material is formed by the feed movement of the rim hole punch, in light of the teachings of Bartelheim, in order to provide a more effective way to assemble articles to one another.

#### ***Response to Arguments***

11. Applicant's arguments with respect to claims 1-3, 5, and 6 have been considered but are moot in view of the new ground(s) of rejection.

#### ***Conclusion***

12. Telephone inquiries regarding the status of applications or other general questions, by persons entitled to the information, should be directed to the group clerical personnel. In as much as the official records and applications are located in the clerical section of the examining groups, the clerical personnel can readily provide status

information. M.P.E.P. 203.08. The Group clerical receptionist number is (703) 308-1148.

13. If in receiving this Office Action it is apparent to applicant that certain documents are missing, e.g., copies of references cited, form PTO-1449, form PTO-892, etc., requests for copies of such papers or other general questions should be directed to Tech Center 3700 Customer Service at (703) 306-5648, or fax (703) 872-9301 or by email to [CustomerService3700@uspto.gov](mailto:CustomerService3700@uspto.gov).

14. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jermie Cozart whose telephone number is 703-305-0126. The examiner can normally be reached on Monday-Thursday, 7:30 am - 6:00 pm.

15. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tom Hughes can be reached on 703-308-1806. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9302 for regular communications and 703-872-9303 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1148.

Other helpful telephone numbers are listed for applicant's benefit.

Allowed Files & Publication	(703) 308-6789 or (888) 786-0101
Assignment Branch	(703) 308-9723
Certificates of Correction	(703) 305-8309
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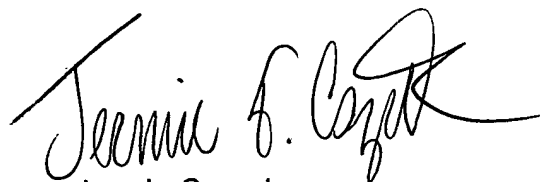
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Information Help line  
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A handwritten signature in black ink, appearing to read "Jermie Cozart". The signature is fluid and cursive, with a long horizontal stroke extending to the right.

Jermie Cozart  
Examiner  
Art Unit 3726

JC  
June 19, 2002